



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/621,249

07/16/2003

Tomohiro Sekine

SUYE:001

1284

7590

08/16/2006

Marc A. Rossi
ROSSI & ASSOCIATES
P.O. Box 826
Ashburn, VA 20146-0826

EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,249

Applicant(s)

SEKINE, TOMOHIRO

Examiner

D. Lawrence Tarazano

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/30/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above claim(s) 0 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1773

DETAILED ACTION

In order to clarify the grounds of rejection the examiner has included new grounds of rejection. The examiner has withdrawn the finality of the previous office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. In this instance the applicants show a wood grained pattern in the drawings and also describe the formation a wood grained product. However, these instructions are very basic. A wood grained pattern involves the formation of both concentric rings and linear lines (the drawing shows concentric rings); the application fails to describe the method in a way to show that the applicant possessed the claimed invention.

4. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear how to make a wood grain pattern. It is clear that the applicants describe the requirements of making a multicolored

Art Unit: 1773

structure; however, the application fails to clearly teach how to make the fine details needed for a wood grain effect (including the formation of concentric circles), not just color streaks.

5. One may point to the specification to understand how a term should be interpreted. The drawings are part of the specification. It is not clear how one would make the type of wood grain disclosed based on the interpretation of the term "wood grain" based on the applicants' disclosure.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. It is not clear what the applicants mean by wood grain; since this is a faux finish it is not clear if the mere difference between a marbleized finish and a wood grain finish is merely a difference in color or actual type of streaking. The specification does not really differentiate the process of forming the two.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

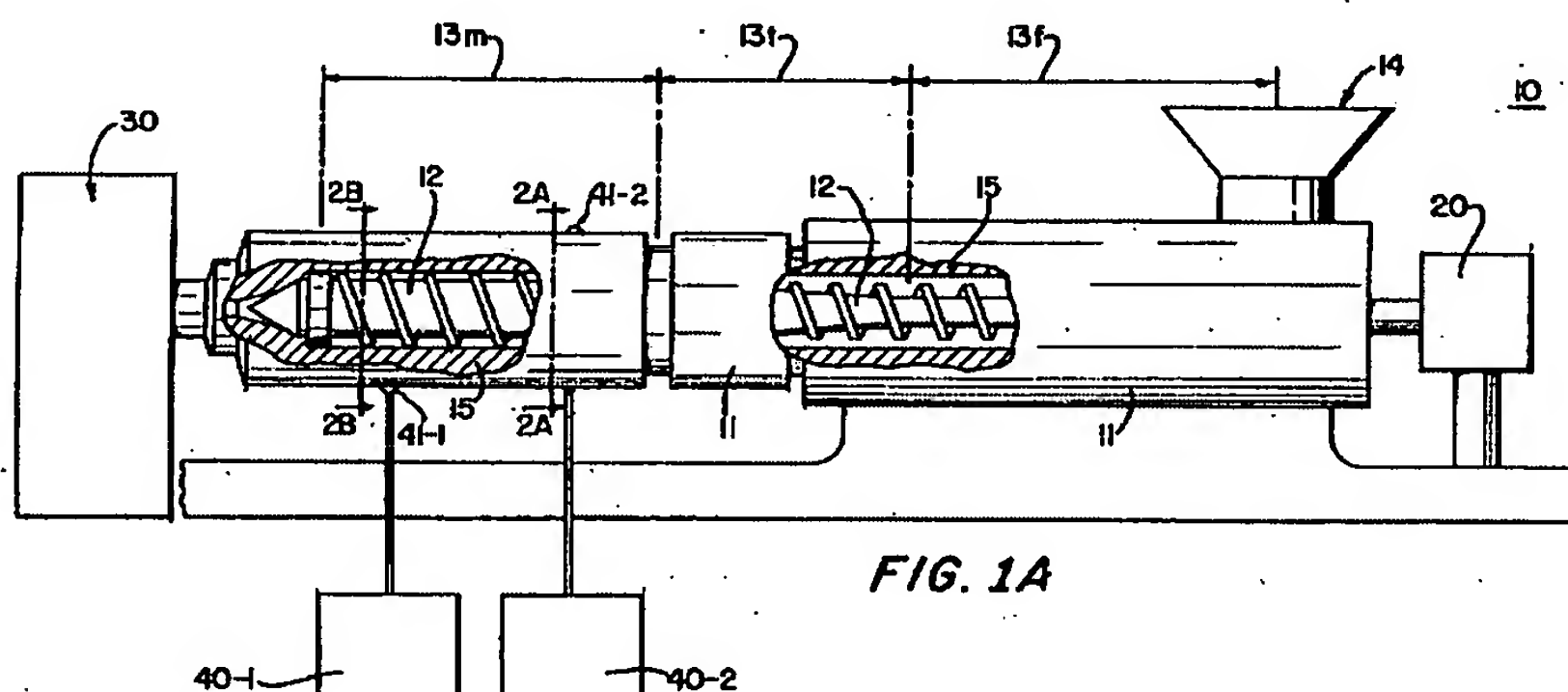
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 1773

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langois (4,125,582).

11. Langois teaches a method of making marbleized parts using a melt stream of multiple colors of thermoplastic materials. The apparatus comprises the claimed screw component.



12. The essential difference between the claimed process and the process taught by the prior art is the addition of a colored transparent layer over the molded structure to control the color of the article. It is common to coat plastic structures with a transparent color layer in order to change the color of the object. This is often done for structure in which one wants aspects of the surface to show through. (e.g. a metallized structure).

13. It would have been obvious to one having ordinary skill in the art to have coated the articles taught by Langois with a transparent color layer depending on the color of the object desired. The color provides no function other than esthetics and such a change would have been obvious to one having ordinary skill in the art at the time the invention was made since changes in color are well within the ordinary skill of the art and merely a design choice.

Art Unit: 1773

14. Regarding claims 2-6, it would have been obvious to one having ordinary skill in the art to have varied the processing conditions and choices of the plastic materials depending on what appearance was desired.

15. Regarding claim 7, the materials in the prior art are made of materials such that color separation is maintained otherwise the final object would be a solid color.

16. Regarding claim 8, It would have been obvious to one having ordinary skill in the art to change the base color and the over coat color to give whatever color effect was desired.

17. Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langois (4,125,582) in view of Beltarmo et al. (EP 1 112781 A2).

18. As discussed above Langois teach plastic substrates having patterns therein. The examiner also stated above that it is known to cover surfaces with a transparent paint to change the appearance or color of the object.

19. Beltarmo et al. teach a method of coating plastic structures with a transparent coating to change the color or light reflecting properties of the substrate (0018, 0022, 0025).

20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the techniques taught by Beltarmo et al. on the surface of the substrates taught by Langois so that different esthetic effects could be obtained.

21. Further in view of both the rejections made above: As a point going to the commercial availability of transparent colored paints, the Acrylicos Vallero (website attached) has made Model Paints since the 1990's, which may be used on plastic substrates. The examiner

Art Unit: 1773

maintains that not only would it have been obvious to one having ordinary skill in the coating industry to coat materials with transparent colored paints when one did not want to obscure the appearance of the substrate and change the color, but this would have been obvious to the average person. The paint industry produces transparent paints, and people both in the industry and outside of the industry would understand how to use them and when they are useful.

Response to Arguments

22. Applicant's arguments filed 5/30/2006 have been fully considered but they are not persuasive. The term "wood grain" is interpreted in view of the applicant's disclosure; this includes the pattern shown in the drawings.

23. The applicants argue that there are different types of wood grain and that "the skilled artisan can change injection conditions such as screw speed and temperature to vary the marbleized patterns of the product to simulate wood-grained patterns" (pages 4-5). The specification must teach how to make and use the claimed invention. While one may rely on the general skill of the art, to make the invention, the examiner believes that skill required in this case is beyond common knowledge. There needs to be clear instruction on how to make a wood grained pattern; especially one that is very lifelike as shown in the drawings. The claimed invention does not meet the requirements of "written description".

24. The applicants have argued that the examiner relies on common knowledge; and the rejection needs to be based on prior art. The examiner feels that the invention is very simple and would be obvious not only to those of ordinary skill in the art but those only somewhat familiar with the coating arts, as transparent paints are readily available both to industry and consumers.

Art Unit: 1773

25. However, in order to respect the applicant's wishes, the examiner has found art, which teaches coating plastic substrates with transparent paints.

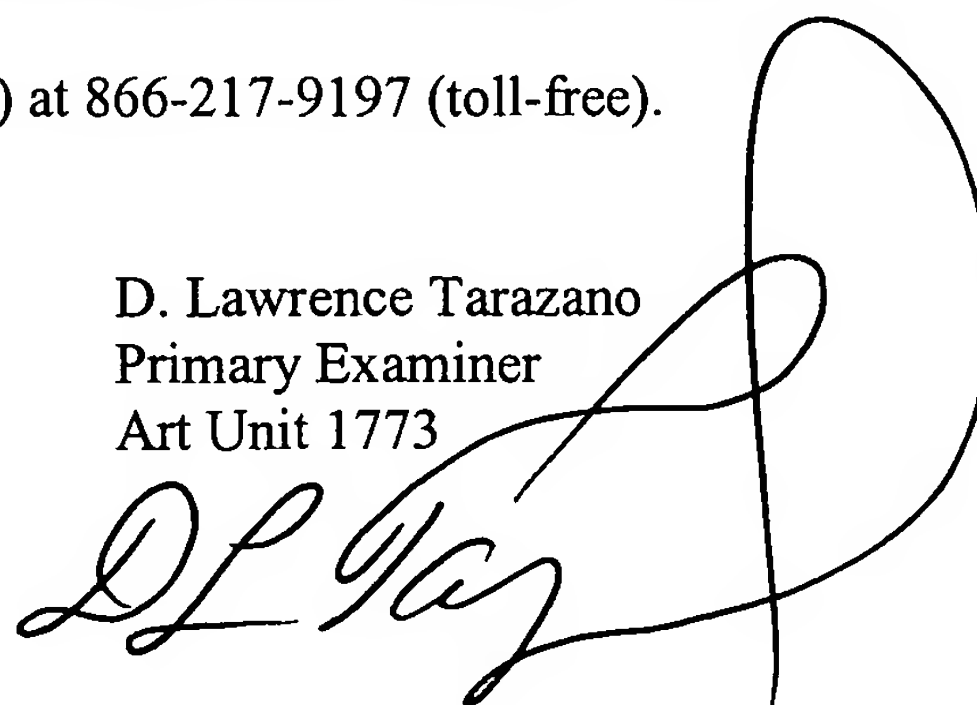
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (571)-272-1515. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Lawrence Tarazano
Primary Examiner
Art Unit 1773

A handwritten signature in black ink, appearing to read 'DL Tarazano', is written over the printed name and title of the examiner. The signature is fluid and cursive, with a large loop at the end.